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Docket No: 0630/1G184US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Suzana PETANCESKA; Sam GANDY; Donald E. FRAIL

Serial No.: 09/695,446

Art Unit: 1615

Confirmation No.: 2608

Filed: 10/24/2000

Examiner: Todd WARE

For: METHODS OF IDENTIFYING AND USING AMYLOID-INHIBITORY
COMPOUNDSRESPONSE

Hon. Commissioner of
 Patents and Trademarks
 Washington, DC 20231

August 1, 2003

Sir:

In response to the Official Action of July 2, 2003, Applicants provisionally elect, with traverse, the invention of Group I, claims 1-6 and 20-25 drawn to methods for reducing amyloid beta or treating a disease through reduction of amyloid beta with an estrogen compound, classified in class 514, subclass 182, with traversal.

The restriction requirement is submitted almost 3 years after the filing of this application on October 24, 2000, and after examination of all of the claims. The instant application was filed with 30 claims reciting subject matter corresponding to the presently pending claims. Applicants have received two office actions on the merits, including a Final Office Action mailed on July 3, 2002. A telephonic interview was held between Applicants and the Examiner on September 24, 2002. Applicants submitted a response to the Final Office Action and filed a Request for Continued Examination (RCE) on January 1, 2003. Subsequently, the Restriction Requirement of July 2, 2003 was issued.

It is respectfully submitted that the subject matter of claims 1-30, pending for almost three years, has already been searched and examined on the merits. With the case searched and examined during the three year time period, a new unforeseen burden should not unexpectedly arise for Applicants RCE. In fact, any present burden on the examiner to perform a search of the subject matter for examination on the merits has already been entirely eliminated. Under MPEP §803, "[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Applicants respectfully submit that not only should this policy be applied to the instant application, but that the Patent Office should consider the extended period of time of the substantive examination of the instant application and the prejudice to Applicants by requiring restriction at this late date.

Applicants also respectfully point out the regulation under 37 C.F.R. § 1.142 wherein a restriction requirement "will normally be made before any action on the merits; however, it may be made at any time before final action." While the finality of the Office Action of July 3, 2002 was withdrawn, requiring restriction at this stage in prosecution seems only to serve the purpose of unnecessarily extending the prosecution time of this application, and indeed is contrary to the regulation.

Accordingly, Applicants respectfully request reconsideration of the restriction requirement. Applicants also reserve the right without prejudice to file the subject matter of the non-elected claims in a divisional application.

Respectfully submitted,


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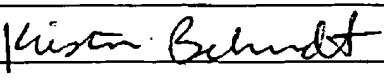
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		Application Number	09/695,446-Conf. #2608
		Filing Date	October 24, 2000
		First Named Inventor	Suzana PETANCESKA
		Art Unit	1615
		Examiner Name	T. Ware
Total Number of Pages in This Submission	4	Attorney Docket Number	0630/1G184US1

ENCLOSURES (check all that apply)

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Atty Docket No.: 0630/1G184US1

Inventor: Suzana Petanceska, et al.

Appn: 09/695,446-Conf. #2608 Filed: Oct. 24, 2000

Title: METHODS FOR IDENTIFYING AND USING
AMYLOID-INHIBITORY COMPOUNDS

Documents:

Transmittal (1 page)

Response to Restriction Requirement

SV 305483436-05

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LDP